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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/342,537 06/29/99 NATSUHARA

M 50395-029

EXAMINER

QM12/0925

MCDERMOTT WILL & EMERY  
600 13TH STREET NW  
WASHINGTON DC 20005-3096

BERRY, M

ART UNIT

PAPER NUMBER

3723

DATE MAILED:

09/25/01

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
09/342,537

Applicant(s)  
Natsuhara et al.

Examiner  
Willie Berry, Jr.

Art Unit  
3723



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Jul 10, 2001.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some\* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_
- 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: \_\_\_\_\_

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## DETAILED ACTION

### *Claim Rejections - 35 USC § 112*

1. Claims 1-7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 5-7 are rejected as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

The following phrases in the claims are vague, indefinite, and/or awkwardly and confusingly worded:

- I. "using a flawing tool" (claim 1, line 3). Is "using a flawing tool" a step in the method of producing plates?
- II. "applying an external force" (claim 1, line 4). Is "applying an external force" a step in the method of producing plates?
- III. "tool is made" (claims 2 and 3, line 2). Is the "tool made" a step in the method of using or making a tool?
- IV. "a cooling medium is not used" (claim 7, line 2). The claim has a negative limitation which makes it indefinite.

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***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1 and 7 are rejected under 35 U.S.C. 102(b) as best understood by the examiner as being anticipated by Boada Sucarrats.

Boada Sucarrats discloses a method of producing ceramics base plates comprising forming a flaw (column 1, lines 56-57) and dividing the ceramics by external force (column 1, lines 57-60).

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 2-6 are rejected under 35 U.S.C. 103(a) as best understood by the examiner as being unpatentable over Boada Sucarrats in view of Yasuga.

Boada Sucarrats discloses as discussed above.

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Boada Sucarrats does not disclose the specific material of the flawing tool, the depth of the flaw, and the specific material of the base plate.

Yasuga disclose a diamond flawing tool (column 1, line 12-13) for the purpose of cutting a hard tile.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified Boada Sucarrats to include the diamond flawing tool as taught by Yasuga for the purpose of cutting a hard tile. The specific depth of the flaw and material of the base plate would have been obvious to one having ordinary skill in the art at the time the invention was made, since it is within the general skill of a worker in the art to select depth and material on the basis of their suitability for the user's preference as a matter of obvious design choice.

### ***Response to Arguments***

6. Applicant's arguments filed 2/20/01 have been fully considered but they are not persuasive. Applicant argues that claims 2-7 further limit the method of producing ceramics base plates. The examiner disagrees because the hardness and material of the base plates do not limit the steps of forming a flaw and dividing a plate. Applicant argues that the negative limitation of claim 7 would not have confused a person of ordinary skill in the art. The examiner disagrees because a negative limitation itself is indefinite and further by adding this negative limitation to the claim, the applicant has not added any additional structure or steps in the method of producing ceramics base plates. Applicant argues that the examiner has not identified where Sucarrats discloses a

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method of producing ceramics base plates. The examiner disagrees because the method has been identified in the action of paper no. 7 and is listed above in the present action. Applicant argues that the examiner has not identified that Sucarrats discloses a sintered base plate. The examiner disagrees because Sucarrats discloses ceramic plates which encompasses ceramic sintered base plates. Applicant argues that there is no motivation to combine Sucarrats in view of Yasuga. The examiner disagrees because it would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified Boada Sucarrats to include the diamond flawing tool as taught by Yasuga for the purpose of cutting a hard tile.

### ***Conclusion***

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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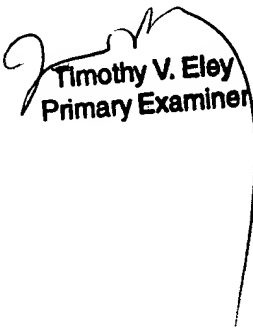
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Any inquiry concerning this communication from the examiner should be directed to Willie Berry whose telephone number is (703) 308-7467.

*WB*

Willie Berry, Jr. :wbj  
September 22, 2001

  
Timothy V. Eley  
Primary Examiner